

### REMARKS

Claims 1-29 are pending in the application. Claims 1, 3, 9, 11, 17, 19, 25 and 27 have been objected to because of informalities. Claims 1-25 have been rejected under 35 U.S.C. §102(b) as being deemed anticipated by U.S. Patent No. 6,347,359 (Smith et al.). Claims 26-29 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over U.S. Patent No. 6,347,359 (Smith et al.)

Of the Claims, Claims 1, 9, 17 and 25 are independent. Claims have been amended to clarify the Applicants' invention. The application as amended and argued herein, is believed to overcome the rejections.

#### Regarding Objections to the Claims

Claims 1, 3, 9, 11, 17, 19, 25 and 27 have been objected to because of informalities. In response, Claims 1, 3, 9, 11, 17, 19, 25 and 27 have been amended to correct the informalities. Removal of the objection to Claims 1, 3, 9, 11, 17, 19, 25 and 27 is respectfully requested.

#### Regarding Rejections under 35 U.S.C. § 102(b)

Claims 1-25 have been rejected under 35 U.S.C. §102(b) as being deemed anticipated by U.S. Patent No. 6,347,359 (Smith et al.).

An embodiment of the Applicants' invention is directed to online data migration from a non-RAID volume to a RAID volume. (*See*, for example, Page 7, line 15 – Page 9, line 20.)

Turning to the cited reference, Smith discusses a method for reconfiguration of a RAID system. (*See*, col. 1, lines 14-16.)

Smith fails to disclose or suggest at least:

“issuing a write request to request writing of the at least one portion of the data into one of a second storage device and at least one location in the first storage device, the at least one location being comprised in a volume of a redundant array of inexpensive disks (RAID), the data being stored in a non-RAID volume in the first storage device.”

and so fails to disclose the invention as recited in claim 1.

In contrast, Smith merely discusses optimizing a process for reconfiguring a disk drive array to eliminate data migration. There is no teaching or suggestion of writing "one portion of data being stored in a non-RAID volume" into "at least one location in the first storage device, the at least one location being comprised in a volume of a redundant array of inexpensive disks" as claimed by the Applicants in Claim 1. Smith merely discusses data migration between RAID volumes due to reconfiguration of a disk drive array.

Claims 2-8 are dependent claims that depend directly or indirectly on claim 1, which has been shown to be patently distinct over Smith. Independent claims 9, 17 and 25 recite a like distinction and are thus patentable over the cited reference. Claims 10-16 depend directly or indirectly on claim 9, and claims 18-24 depend directly or indirectly on claim 17 and are thus patentable over the cited reference.

Accordingly, the present invention as now claimed is not believed to be anticipated by the cited reference. Removal of the rejections under 35 U.S.C. § 102(b) and acceptance of claims 1-25 is respectfully requested.

Regarding Rejections under 35 U.S.C. § 103(a)

Claims 26-29 have been rejected under 35 U.S.C. §103(a) as being deemed unpatentable over U.S. Patent No. 6, 347,359 (Smith et al.)

To establish a prima facie case for obviousness under 35 U.S.C. 103(a), (1) there must be some suggestion or motivation to combine reference teachings; (2) there must be a reasonable expectation of success; (3) the references when combined must teach or suggest all the claim limitations. For the reasons discussed below, it is respectfully submitted that the Office has not established a prima facie case under 35 U.S.C. 103(a) for claims 26-29 and that therefore, claims 26-29 are allowable.

Claims 25-29 are dependent claims that depend directly or indirectly on claim 25, which has been shown to be patently distinct over Smith.

Furthermore, the Office action does not identify any evidence in Smith indicating or in any way suggesting the desirability of the proposed modifications. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

Accordingly, the present invention as now claimed is not believed to be made obvious from the cited references. Removal of the rejections under 35 U.S.C. § 103(a) and acceptance of claims 26-29 is respectfully requested.

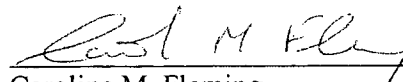
CONCLUSION

In view of the foregoing, it is submitted that all claims (claims 1-29) are in condition of allowance. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the above-referenced application.

Please charge any shortages and credit any overcharges to Deposit Account Number 02-2666.

Respectfully submitted,

Date: 8/22/06



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